

Reply Brief
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: November 2, 2009

Signature: 

(Donna Dobson)

Docket No.: 61135/P024US/10303362
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Craig Ogg

Application No.: 10/677,829

Confirmation No.: 9780

Filed: October 2, 2003

Art Unit: 3628

For: SYSTEM AND METHOD FOR ACCESSING A
REMOTE POSTAGE METER ACCOUNT
FROM A DEVICE THAT HAS A DEDICATED
LOCAL METER AND ACCOUNT

Examiner: D. Vetter

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

As required under § 41.41(a)(1), this Reply Brief is filed within two months of the Examiner's Answer dated September 2, 2009, and is in furtherance of the Appeal Brief filed on June 22, 2009.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

- I. Status of Claims
- II. Ground of Rejection to be Reviewed on Appeal
- III. Argument
- IV. Conclusion

I. STATUS OF CLAIMS

The status of claims remains as identified in the Appeal Brief submitted June 22, 2009, which is as follows:

A. Total Number of Claims in Application

There are 28 claims pending in application.

B. Current Status of Claims:

1. Claims canceled: 1-13 and 28-38
2. Claims withdrawn from consideration but not canceled: 39-52
3. Claims pending: 14-27 and 39-52
4. Claims allowed: None
5. Claims rejected: 14-27

C. Claims on Appeal:

The claims on appeal are claims 14-27.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed remain as identified in the Appeal Brief submitted June 22, 2009, which are as follows:

Claims 14-18, 20-21, and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,151,591 (hereinafter Pierce) in view of International Patent Publication No. WO 02/093798 (hereinafter Willoughby).

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierce in view of Willoughby, and further in view of U.S. Patent No. 5,742,683 (hereinafter Lee).

Claims 22 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierce in view of Willoughby, further in view of U.S. Patent No. 5,812,400 (hereinafter Eddy).

III. ARGUMENT

Appellant notes that Appellee has substantially maintained the reasoning set forth in past actions which have already been addressed by the Appeal Brief. As such, for the sake of brevity the arguments in this Reply Brief do not repeat the arguments presented in the Appeal Brief. Instead, this Reply Brief addresses specific assertions and issues raised by the Examiner's Answer.

A. The Proposed Combination Fails to Teach Limitations of the Claims

Claim 14 recites “*configuring a local postage evidencing device to communicate with a plurality of vendors* providing access to a plurality of remote postage accounts” (emphasis added). Appellee asserts that Appellant is arguing a preferred embodiment from the specification wherein the local device can ask directly with the vendor, without the use of software to tools. *See* Examiner's Answer at page 7. The claim requires that the local postage evidencing device is configured to communicate with vendors. Willoughby teaches an API which communicates with vendors and handles transaction processing. In the asserted combination there is no local device which communicates, or is configured to communicate, with a plurality of vendors. Rather, the asserted combination, and the teachings of Willoughby, indicate that the API must act as a remote server between the vendors and the local device, where only the API can communicate with the vendors. Accordingly, as shown in the Appeal Brief at pages 6-8, the cited references fail to teach “configuring a local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts.” Therefore, Appellant requests that the rejection be overturned.

B. Appellant's Assertions of Incompatibility are Supported by Adequate Evidence

In the Examiner's Answer, Appellee asserts that Appellant's arguments against the feasibility of the proposed combination are not supported by adequate evidence. Appellant's arguments, however, directly focus on the teachings, or lack thereof, of the cited references. Clearly, the cited references are “evidence” which can be relied upon in the present proceeding.

Further, Appellee appears to recognize the shortcomings of the references shown in the Appeal Brief, but then argues that the record does not indicate that the combination described by the Appeal Brief, and its corresponding problems, reflect the only manner in which to combine the teachings of the references. However, Appellee has failed to suggest any different manner to combine the asserted references which can be supported by their respective disclosures. Appellee's present reasoning effectively holds Appellant to a standard that would require the cited art itself to disclose that a combination would be "impossible or even unworkable" in order to prove that the asserted combination is improper. *See* Examiner's Answer at page 8. Clearly, this is not an applicable standard. Appellant notes that the Appeal Brief describes in detail where portions of the cited references indicate the references cannot be combined in the manner set forth by Appellee. *See* Appeal Brief at pages 8-10. Appellee has failed to give any adequate response to such arguments. As such, the evidence of record supports Appellant's positions set forth in the Appeal Brief.

Appellee's application of *In re Ratti* is likewise deficient. Appellee sets forth the proper two-prong test of *Ratti*, but misapplies the facts of the preset case. A combination is improper if it requires a substantial reconstruction and redesign of the prior art, and if the combination would change the basic principles under which the prior art was designed to operate. *In re Ratti*, 270 F.2d 810; 123 USPQ 349 (CCPA 1959). As shown on pages 8-10 of the Appeal Brief, the methods of transaction processing for each of the separate asserted references are fundamentally different and would conflict if the references, and their corresponding functionality, were to be combined. Because of the fundamental differences in teachings of the references, a substitution of one for the other would impermissibly change the basic principles of operation of the cited art. Appellee attempts to marginalize these points and states that discussing the transaction processing functionality is tantamount to discussing the "minutia" of the references. However, transaction processing is one of the primary concerns in the art of postage metering, which is why both references go into extensive detail regarding how transactions are processed. Clearly, a rejection that attempts to alter the methods employed for transaction processing in the cited references is improper. Accordingly, Appellee's analysis as set forth in the Examiner's Answer is flawed.

C. Appellee Has Not Set Forth a Proper Reason to Combine the Cited Art

In the Appeal Brief, Appellant argued that the asserted reasons to combine references is logically flawed, thereby making the present rejections are improper under the mandates of *KSR v. Teleflex* 550 U.S. 398; 82 U.S.P.Q.2d. 1385 (2007). In the Appeal Brief on page 11 Appellant discussed Appellee's stated reasoning for combining references which was to allow a user to "select another vendor if a particular remote postage provider suffers downtime." Appellant's argument is that Pierce already compensates within the system for devices in the network suffer downtime. As such, there is no reason that one with skill in the art would look to another reference for downtime compensation. Appellee now asserts a theory that Pierce contains multiple local postage meters that must initially get funds from a remote vendor, and that vendor is the one that may suffer downtime. This assertion, however, goes against the Appellee's reading of Pierce throughout the entire examination. Appellee has always asserted that the separate meters of Pierce were the locations of the remote accounts (*i.e.*, not local accounts), and that Willoughby can be used to modify those remote accounts to complete the functionality of a claimed invention. *See* Final Office Action at 4. Appellee cannot rely on one portion of Pierce as teaching one concept to assert that limitations of the claims are taught, while relying on the same portions to teach a different concept in order to fabricate a reason to combine references. The flaws in the new logic set forth by Appellee call into question how the cited art is being applied to the claims. Because both of the asserted readings of the Pierce reference cannot be simultaneously implemented, sufficient reasons for combining references (or alternatively, reasons for rejection) have not been set forth. Therefore, the asserted reasons to combine still do not adequately show "what may have prompted a person of ordinary skill in the relevant field to combine elements" as required by the law. *KSR v. Teleflex* 550 U.S. 398; 82 U.S.P.Q.2d. 1385 (2007). Accordingly, the rejections are not proper and should be overturned.

IV. CONCLUSION

In view of the above, and in view of the Appeal Brief, Appellant submits that the present rejections claims 14-27 are improper, and therefore respectfully requests that the Board overturn said rejections.

Appellant believes no fee is due with this response. Please charge any fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No.

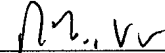
Application No.: 10/677,829

Docket No.: 61135/P024US/10303362

61135/P024US/10303362 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: November 2, 2009

Respectfully submitted,

By 
R. Ross Viguet
Registration No.: 42,203
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8185
(214) 855-8200 (Fax)
Attorney for Appellant